



Term C 108
Ex parte

01-17-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #71

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re trademark application : Vitaflex Dr. Walter Mauch GmbH
Serial No. : 75/615,858
Filed : January 5, 1999
Mark : BY DR. MAUCH
Class : 025
Examiner : Amos T. Matthews
Attorney's Docket : FELD-T008XX

Trademark Law Office 108

I hereby certify that this correspondence is being deposited with
the United States Postal Service as first class mail in an
envelope addressed to: Box TTAB, Commissioner for Trademarks, 2900
Crystal Drive, Arlington, VA 22202-3513 on 1-14-02

By: Charles L. Gagnebin III
Charles L. Gagnebin III
Registration No. 25,467
Attorney for Applicant

RECEIVED
JAN 23 9:05
LAW OFFICE 108

REPLY TO EXAMINING ATTORNEY'S BRIEF ON APPEAL

Application No. 75/615,858
Filed: January 5, 1999

TABLE OF CONTENTS

| | <u>Page</u> |
|--|-------------|
| I. Reply to Examining Attorney's Appeal on Brief | 1 |
| II. Table of Cases | iii |

TABLE OF CASES

| | <u>Page</u> |
|--|-------------|
| <u>Sauer</u> , 27 USPQ2d 1073 (TTAB 1993) | 1 |
| <u>Reed v. Bakers Engineering & Equipment Co.</u> , 100 USPQ 196, (PO Ex. Ch. 1954) | 1 |
| <u>Laub v. Industrial Development Laboratories, Inc.</u> , 121 USPQ 595 (TTAB 1959) | 1 |
| <u>New John Nissen Mannequins</u> , 227 USPQ 569 (TTAB 1985) | 2 |
| <u>D.B. Kaplan Delicatessen</u> , 225 USPQ 342 (TTAB 1985) | 2 |

TRADEMARK LAW OFFICE 108
Serial Number: 75/615858
Mark: BY DOC MAUCH

Please Place on Upper Right Corner
**of Response to Office Action ONLY **

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re trademark application : Vitaflex Dr. Walter Mauch
GmbH
Serial No. : 75/615,858
Filed : January 5, 1999
Mark : BY DR. MAUCH
Class : 025
Examiner : Amos T. Matthews
Attorney's Docket : FELD-T008XX

Trademark Law Office 108

REPLY TO EXAMINING ATTORNEY'S BRIEF ON APPEAL

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

The following is in reply to the Examining Attorney's
Appeal Brief dated December 13, 2001:

The Examining Attorney relies upon several cases in
his argument. The Sauer, 27 USPQ2d 1073 (TTAB 1993) case
involved the usurpation of the nickname of a star athlete
without any colorable consent and is thus quite irrelevant.
The Reed v. Bakers Engineering & Equipment Co., 100 USPQ
196, (PO Ex. Ch. 1954) case is similar in that there was no
writing that could be seen as a consent. In re Laub v.
Industrial Development Laboratories, Inc., 121 USPQ 595

(TTAB 1959) there was also no writing, just a course of action giving rise to an allegation of consent to use. In re New John Nissen Mannequins, 227 USPQ 569 (TTAB 1985), the party Nissen at least signed incorporation papers, but nothing in the nature of a consent or conveyance of rights in a trademark.

The D.B. Kaplan Delicatessen, 225 USPQ 342 (TTAB 1985) case on the other hand is quite on point despite the arguments of the Examiner. The marital property agreement is a conveyance of the trademark rights including a number of registrations and applications. The language of transfer is to all rights which can only be seen as an exclusion for Dr. Mauch from the business bearing his name.

Regarding the request of the Examiner to exclude marketing and sales documents, to the extent that this may be new matter, the Board has broad discretion to allow such matter, which discretion is, to the extent necessary, requested given the complications of foreign based applications.

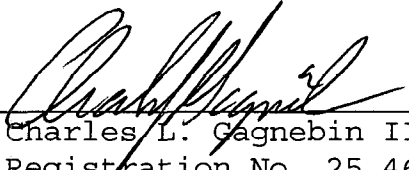
Application No. 75/615,858

Filed: January 5, 1999

Reversal of the Examining Attorney and registration
are requested.

Respectfully submitted,

VITAFLEX DR. WALTER MAUCH
GMBH

By: 
Charles L. Gagnebin III
Registration No. 25,467
Attorney for Applicant

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEOVICI LLP

Ten Post Office Square
Boston, Massachusetts 02109
Telephone: (617) 542-2290
Telecopier: (617) 451-0313

CLG/dkh/265509